

REMARKS

At the outset, Applicants thank Examiner Gibbs and Examiner Lacourciere for their time for participating in a telephonic interview with Alison Corkery on March 1, 2004.

The Examiner and Applicants' representative proceeded to discuss the rejection under the judicially created doctrine of obviousness-type double patenting over claim 1 of U.S. Patent No. 5,591,721 ("the '721 patent") contained in the Advisory Action mailed January 5, 2004.

Applicants' representative requested clarification regarding the rejection contained in the Advisory Action.

The Examiners explained that they are interpreting claim 1 of the '721 patent as a broad claim because due to the use of "comprising" language, the oligonucleotide could comprise a portion that has phosphorothioate internucleotide linkages between every nucleotide and could further comprise non-phosphorothioate internucleotide linkages. The Examiners explained their interpretation that the use of the term "comprising" before this clause in claim 1 of the '721 patent indicates that it applies to the internucleotide linkages. Thus, the Examiners feel that the oligonucleotide could include other nucleotides with other types of internucleotide linkages.

Applicants' representative indicated that Applicants will consider the rejection in light of this information.

In addition, Applicants note that the Examiner has not returned an initialed copy of the Form PTO-1449 submitted with the Information Disclosure Statement filed October 4, 2002. Applicants respectfully request that the Examiner return an initialed copy of the Form PTO-1449 submitted therewith with the next communication.

Claims 1-11 and 15-27 are currently pending in the application. These claims stand rejected under the judicially created doctrine of obviousness-type double patenting over claim 1 of U.S. Patent No. 5,591,721.

Applicants enclose herewith a Terminal Disclaimer over U.S. Patent No. 5,591,721. As stated in M.P.E.P. § 804.02(II), the “filing of a terminal disclaimer to obviate a rejection based on nonstatutory double patenting is not an admission of the propriety of the rejection. *Quad Environmental Technologies Corp. v. Union Sanitary District*, 946 F.2d 870, 20 USPQ2d 1392 (Fed. Cir. 1991). The court indicated that the ‘filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting, and raises neither a presumption nor estoppel on the merits of the rejection.’”

Accordingly, Applicants respectfully request that this rejection be reconsidered and withdrawn.

CONCLUSIONS

Applicants enclose herewith a Petition for a One Month Extension of Time pursuant to 37 C.F.R. § 1.136, until March 24, 2004, based on the Notice of Appeal received by the USPTO on December 24, 2003. Please charge Deposit Account No. 08-0219 the \$55.00 fee for this purpose.

Applicants also herein request continued examination of the application according to 37 C.F.R. § 1.114. Please charge the same deposit account the \$385.00 fee set forth in 37 C.F.R. § 1.17(e) for this purpose.

If the Examiner believes that any further discussion of this communication would be helpful, she is invited to contact the undersigned at the telephone number provided below.

No fees are believed to be due in connection with this response. However, please charge any underpayments or credit any overpayments to Deposit Account No. 08-0219.

Respectfully submitted,
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